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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Nighttime Pediatrics, Inc.
v.
Dimensions Healthcare System

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Opposition No. 118,016
to application Serial No. 75/713,549

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Philip B. Barnes of Whiteford, Taylor & Preston LLP for Nighttime Pediatrics, Inc.

E. Scott Johnson of Ober, Kaler, Grimes & Shriver for Dimensions Healthcare System.

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Before Cissel, Rogers, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Dimensions Healthcare System (applicant) has applied to register the mark shown below for services identified as "after-hours emergency pediatric care" in International Class 42."[1]

[1] Serial No. 75/713,549, filed May 25, 1999. The application contains an allegation of a bona fide intention to use the mark in commerce.

The mark contains the following wording: "NIGHTLIGHT PEDIATRIC CARE WHEN IT CAN'T WAIT 'TIL MORNING." Applicant disclaimed the term "Pediatric Care."

Nighttime Pediatrics, Inc. (opposer) has opposed the registration of applicant's mark. In its Notice of Opposition, it refers to the following mark:

Opposer claims that "[t]his Application was accepted for registration on April 5, 1994" and is incontestable. Notice of Opposition, p. 4.[2]

[2] Opposer attached only a copy of the drawing of the mark along with its Notice of Opposition, but it did not include either a registration number or a copy of the registration. The record contains a copy of the registration of the mark in Ex. 7 of the Graw deposition (00202-00204). Registration No. 1,829,679 issued April 5, 1994; Section 8 and 15 affidavits accepted and acknowledged, respectively, by the Office. The registration contains a disclaimer of the term "Nighttime Pediatrics." Opposer has not submitted a status and title copy of this registration. However, applicant "admits that Opposer has used

Opposer also refers to "Opposer's Secondary Mark" and states that opposer "frequently uses a design to promote its after-hours emergency pediatric medical care practice consisting of a crescent moon with a picture of an infant holding a teddy bear sitting in the crescent moon surrounded by stars." Notice of Opposition, p. 3. In its brief, opposer refers to the design as its "trade dress." Brief at 4. The record contains numerous exhibits showing, and testimony regarding, opposer's use of this design. Graw test. dep. at 111-59, Exhibits 9 and 14. Opposer uses this design together with its registered mark on brochures and advertising for its

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a registered mark in connection with its after-hours emergent medical care practice in Maryland for some time" and that the "dates and nature of the registration of Opposer's mark referred to in Paragraph 6 speak for themselves." Answer, p. 2. In addition, applicant has discussed the merits of the likelihood of confusion issue involving the services in its application and opposer's registration. Therefore, inasmuch as applicant has treated the registration as being of record, it is "deemed by the Board to be of record in the proceeding." TBMP § 703.02. See also Tiffany and Company v. Columbia Industries, 455 F.2d 582, 173 USPQ 6, 8 (CCPA 1972) ("Since appellee had fair notice of the case it had to meet, it would work an injustice on appellant to deprive it of the right to rely on the statutory presumptions flowing from [the] registration" that was not properly submitted.); Crown Radio Corp. v. Soundscriber Corp., 506 F.2d 1392, 184 USPQ 221, 222 (CCPA 1974)("Appellee did not submit copies of its aforementioned registrations with the verified petition for cancellation … We agree with the board that appellant has admitted the existence of appellee's "SOUNDSCRIBER" registrations. Therefore, we agree with the board that the sole issue to be determined in this proceeding is whether there is a likelihood of confusion").

services. With its Notice of Opposition, opposer attached a copy of this design shown below.

Opposer alleges that "[s]ince first use of Opposer's Marks [opposer's registered mark and its 'secondary mark'] in at least August, 1989, the Opposer has continuously used them to promote and advertise its after-hours emergency pediatric medical care practice." Notice of Opposition, p. 3. As a result, opposer concludes that "[g]iven the confusing similarity of the Applicant's Mark to the Opposer's Marks, and the Opposer's undisputed long-standing and continuous use of its marks, the Opposer believes that Applicant's use of the Applicant's Mark is likely to cause confusion with its marks." Notice of Opposition, p. 6.

Applicant has denied the salient allegations of the Notice of Opposition.

The Record

There are several disputes regarding the contents of the record. The inclusion in the record of the following items is not disputed: the file of the involved application; the trial testimony depositions of applicant's former vice-president, Lisa Schiller, and Scott VanDerMeid of Laurel Marketing and Design, both with accompanying exhibits; the testimonial deposition of Riccardo Pallia, applicant's vice-president; portions of the discovery depositions taken by applicant of Dianne Myers, Natwartal B. Shah, Lisa Wannemacher, and Robert Graw, Jr., with accompanying exhibits submitted by applicant's Notice of Reliance[3]; and copies of third-party registrations submitted under a Notice of Reliance. Both parties agree that the discovery deposition of Dana O. Lynch, with accompanying exhibits, is in the record, so it will be considered part of the record.

Opposer has also submitted the testimonial deposition of Daryl S. Judy. With its trial brief, opposer submitted the discovery depositions taken by

[3] Opposer, with its trial brief, submitted the entire discovery depositions of Graw, Shah, and Myers, and applicant has waived

opposer of Riccardo Pallia, Julie Hoffman, and Lisa Schiller; copies of opposer's answers to interrogatories and applicant's answers to interrogatories; and a brochure and an advertisement. Applicant has filed a motion, discussed below, to strike these items.

Both parties have filed briefs. An oral hearing was not requested.

Applicant's Motion to Strike

Applicant objects to, and has moved to strike, the following exhibits to opposer's trial brief:

C. Opposer's Answers to Applicant's Interrogatories

D. Applicant's Answers to Opposer's Interrogatories

I. Testimonial Deposition of Daryl Judy

J. Discovery Deposition of Riccardo Pallia

K. Discovery Deposition of Julie Hoffman

L. Discovery Deposition of Lisa Schiller

M. Nighttime's Color Brochure

N. Nighttime's Advertisement[4]

Regarding Exhibits C and D, applicant argues that they were attached to opposer's trial brief without having been submitted under a Notice of Reliance. In addition, applicant objects to Exhibit C, opposer's

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any objection to opposer's submission. Applicant's Motion to Strike, p. 2, n. 2.

answers to interrogatories, as hearsay. Opposer responds by arguing that Exhibit D, applicant's answers to interrogatories, consists of exhibits to the Hoffman discovery deposition.[5] Opposer also argues that "[t]he references made to the Answers to Interrogatories are immaterial and were only included in the Trial Brief for the purpose [of] providing a full and complete background for the Board." Opposition to Motion to Strike, p. 3.

"Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony." TMEP § 705.02; Maytag Co. v. Luskin's, Inc., 228 USPQ 747, 748, n. 5 (TTAB 1986). For that reason alone, opposer's Exhibits C and D will not be considered. In addition, a party may not normally offer its own answers to interrogatories even under a Notice of Reliance. 37 CFR § 2.120(j)(3)(i)(5). We agree that Exhibit D is evidentiary material that is not of record, and we will give it no consideration. Exhibit C would only be of record if the

[4] Opposer has withdrawn this exhibit. See Opposer's Opposition to Applicant's Motion to Strike, p. 1, n. 1.

deposition of Julie Hoffman were of record. Because this deposition is not of record (see the following discussion), we will not consider Exhibit C either.

Regarding Exhibits J (Pallia), K (Hoffman) and L (Schiller), applicant argues that these discovery depositions taken by opposer were never submitted by Notices of Reliance and that they exceeded the scope of an agreement between the parties to use discovery depositions. Opposer contends that it had the right to make of record the discovery depositions "of any witnesses it designates as testimonial witnesses, including those that Nighttime deposed… Clearly, Nighttime had the right to designate for testimonial purposes any witness, regardless of who noted the discovery deposition of the witnesses." Opposition to Motion to Strike, p. 8. The two sentences that opposer relies upon for this contention are in a letter that memorializes a telephone conversation between the parties' counsels as follows:

> You [John M.G. Murphy, counsel for applicant] have indicated that your clients, contrary to Mr. Gogel's correspondence of July 3, 2001, will now agree that my client [opposer] may utilize discovery deposition transcripts taken in this matter of Nighttime's witnesses for testimonial purposes. We have agreed that the entire transcripts will be submitted.

[5] This deposition is also subject to applicant's motion to strike.

Applicant's Reply to Opposer's Opposition to Motion to Strike, Ex. 4.

It is difficult to read the agreement as opposer has suggested. It seems apparent that the reference in the letter to "Nighttime's witnesses" is a reference to the witnesses who were identified by opposer (Nighttime) and who were deposed by applicant during discovery. It would be unusual to read the phrase "discovery deposition transcripts taken in this matter of Nighttime's witnesses" to include discovery depositions taken by opposer of applicant's witnesses. Inasmuch as opposer had not submitted these discovery depositions of applicant's witnesses with a Notice of Reliance during its testimony period, applicant had no notice prior to briefing that opposer was interpreting the agreement more broadly than applicant was.

Applicant admits that Hoffman was a corporate designee whose discovery deposition testimony would be admissible if properly filed under a Notice of Reliance. Motion to Strike, p. 6, n.5. Pallia's discovery deposition testimony, because he is a vice-president of applicant, also could have been submitted by a Notice of Reliance. 37 CFR § 2.120(j)(1); TBMP § 709. However, a party must submit depositions by means of a Notice of

Reliance, not by attaching them to its brief. Because opposer did not do this, we will not consider the discovery depositions of Pallia, Hoffman, or Schiller.[6]

Regarding Exhibit M, which is a color reproduction of a black and white exhibit of record (Graw, Ex. 9), we sustain applicant's objection and we will not consider this exhibit. While a black and white exhibit was introduced during the Graw deposition and the witness discussed color, there is no indication that the color brochure was introduced during the testimony. It is too late at the briefing stage to submit a new exhibit, even if it simply a color version of one submitted previously.

Finally, applicant has objected to the testimonial deposition of Daryl Judy. Applicant argues that it "agreed to allow [opposer] to take th[is] testimonial deposition … during [applicant's] testimony period." Motion to Strike, p. 4. When the testimony was taken during opposer's
rebuttal period, applicant objected on the ground that it was improper rebuttal. Opposer argues that the "deposition was scheduled by agreement of counsel for August 6, 2001. However, Dimensions' counsel canceled

[6] Schiller was not called as a corporate designee and her deposition would not have been admissible under a Notice of Reliance.

that deposition and the parties then agreed to the October 30, 2001 testimonial deposition date. The deposition of Mr. Judy was, in fact, taken on October 30, 2001 within the rebuttal period." Opposition to Motion to Strike, p. 6. Opposer further argues that the testimony "is proper rebuttal of Nighttime's contention that no confusion exists between the disputed marks." Opposition to Motion to Strike, p. 7. Applicant admits it had an opportunity to take a discovery deposition of Mr. Judy prior to the testimonial deposition. Reply to Opposition to Motion to Strike, p. 4, n.4 (Applicant "decided to cancel the discovery deposition of Mr. Judy because after speaking with Mr. Judy … a discovery deposition was not warranted").

We deny applicant's motion to strike Mr. Judy's testimony. The parties had agreed to take the deposition outside the normal time for doing so. Apparently, the difficulty in arranging a mutually convenient date led to the deposition being held during opposer's rebuttal period, rather than during applicant's testimony period.

In a case where there were allegations of inadequate notice concerning the testimony of a witness, the Board has permitted the testimony.

> In this regard, our reading of the record fails to show any material prejudice to registrant since it

> did receive advance oral notice that there would be a substitute for the Beech Aircraft employee originally named as a witness and the substitute would also be a Beech employee (whose name was not made known until the day of the deposition). Registrant had a full opportunity for cross-examination of the witness and appears to have exercised it. Of course, it could have requested an extension or postponement if it felt that the circumstances of the substitution left it inadequately prepared to deal with the evidence of petitioner's use of the term LIGHTNING which the Beech employees (original and substitute) were being called upon to document").

Beech Aircraft Corporation v. Lightning Aircraft Company Inc., 1 USPQ2d 1290, 1291 (TTAB 1986).

In the instant case, the parties were obviously attempting to secure the testimony of the witness. The evidence on this subject is not entirely clear, but it appears that it is within the parties' admitted understanding that the deposition of Mr. Judy would take place outside of opposer's testimony period. We do not hesitate to add that, even if this were not the case, Mr. Judy's testimony would not be improper rebuttal.

Priority

Priority is not an issue because opposer is the owner of Registration No. 1,829,679. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

However, opposer also relies on its common law rights in what it describes as trade dress that opposer

says it uses along with its registered mark. Opposer's owner testified that the design of the child in the moon was developed in 1995 and used on advertising for the services that was distributed that same year and that opposer has continued to use that design. Graw test. dep., pp. 114-15, 122 and Exhibit 9. Opposer's evidence has established that it has priority in this case based on its registration and whatever common law rights it has in the design that it uses along with its registered mark. Applicant does not argue that it has an earlier date of first use.[7]

Facts

On May 25, 1999, applicant filed an application to register the mark NIGHTLIGHT PEDIATRIC CARE WHEN IT CAN'T WAIT 'TIL MORNING and design for services identified as "after-hours emergency pediatric care." After applicant disclaimed the words "Pediatric Care" in its mark, the application was allowed.

In July 1999, Nightlight Pediatrics opened at the Bowie Health Care facility in Bowie, Maryland. Schiller test. dep., p. 11; Pallia test. dep., pp. 7-8.

[7] The application is an intent-to-use application filed on May 25, 1999. Applicant's witness has also testified that the Nightlight Pediatric Care Center did not open until July 1999. Schiller test. dep., p. 11. Applicant has not established a

Applicant's facility is different from a doctor's office in that it handles urgent and emergent[8] care and it is open only in the evenings and between noon and midnight on Saturdays and Sundays. Pallia test. dep., pp. 8-9. There is no type of medical emergency that applicant's facility cannot handle. Pallia test. dep., pp. 9-10.

Opposer, on the other hand, filed an application to register the mark NIGHTTIME PEDIATRICS and design for pediatric medical services on August 25, 1992. The registration issued on April 5, 1994, after opposer disclaimed the words "Nighttime Pediatrics." That registration file contains a consent to registration from the owner of Registration No. 1,655,085 for the mark NIGHTIME PEDIATRICS [using a single "T" in "nighttime"] for pediatric medical services. The consent declares that "there is no likelihood of confusion as to the concurrent use and registration of the two marks due in part to the differences between them, and the advertising of the services." Graw test. dep., Exhibit 8, 00309.

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date of first use in commerce earlier than the constructive date of first use established by its application's filing date.

[8] The parties appear to use the term "emergent" in the sense of "requiring immediate action." *Webster's II New Riverside University Dictionary* (1984).

Opposer's business is to "oversee and develop after-hours urgent care pediatrics practice[s]." Graw test. dep., p. 11. Although it does not directly provide health care services, it "licensees the name, and is the oversight company for various Nighttime Pediatrics locations." Id. There are Nighttime Pediatrics locations in Annapolis, Pasadena and Rockville, Maryland. Id. Opposer's facilities deliver urgent care, not emergent, care. Urgent care is "less than emergent care;" it is the "kind of care you receive in a pediatrician's office." Graw test. dep., pp. 155-56.

On March 27, 2000, opposer filed its opposition to the registration of applicant's mark.

Likelihood of Confusion

We will analyze the issue of likelihood of confusion using the factors that were articulated by one of our primary reviewing court's predecessors, the Court of Customs and Patent Appeals, in the case of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). See also Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). The first factor concerns the similarity or dissimilarity of the marks as to appearance, sound, connotation, and commercial impression. The marks are set out below:

Opposer argues that the "slight differences between the Nighttime mark and the Nightlight mark, the words 'time' and 'light,' are insignificant." Opposer's Br. at 10. The designs of both marks feature a crescent-shaped moon. Opposer's main argument is that, when the marks are viewed in their entireties, the marks are similar in sound, appearance, connotation, and impression. Opposer further argues that its trade dress of a child cradled in a crescent-shaped moon reinforces the similarity with applicant's mark, which includes a sleeping infant in a crescent-shaped moon.

Applicant argues that opposer's mark is a very weak mark because "it consists of widely used images [and] includes generic words… Smiling crescent moons, stars, 'Nighttime' and 'Pediatrics'" are very common elements. Applicant's Br. at 18-19. Applicant cites opposer's own testimony for the proposition that the words "`Nighttime Pediatrics' are not only weak, they are generic." Applicant's Br. at 20. Applicant's Br. at 21 quoting Graw test. dep. at 62-63 (Describing paperwork involving

the prosecution of its application in the PTO, Graw stated that "when we went in originally they said you can't take the name. It's too generic and too similar and other people have it and I think this is a discussion about that"). However, the quote appears to be his description of what someone told him and not an admission of his part that the words are generic. See also Graw test. dep., p. 80. Applicant has also submitted evidence to show that "nighttime" is descriptive of a product or service that is useful at nighttime. Applicant also pointed out that opposer distinguished the mark NIGHTTIME PEDIATRICS from NIGHTIME PEDIATRICS by the number of "T's" in each mark. "If the names 'Nightime Pediatric Clinic' (with one T) and 'Nighttime Pediatrics' (with two Ts) are not confusingly similar, then 'Nighttime Pediatrics' and 'Nightlight Pediatric Care' cannot be, as well." Applicant's Br. at 31.

In summary, applicant argues that the marks are not similar because the words in opposer's registration are disclaimed, opposer obtained registration of its mark with the consent of a prior registrant who owned the mark NIGHTIME PEDIATRICS, and moon designs are not uncommon, particularly for children's products.

At first glance, applicant's and opposer's marks seem similar. The words "nighttime pediatrics" and "nightlight pediatric care" are very similar in sound and appearance. Even one of applicant's witnesses became confused during his deposition. Pallia test. dep. at 23-24. Their meanings would also be similar because they either suggest or describe pediatric care that is available after dark or when other pediatricians' offices are closed. Furthermore, the additional wording in applicant's mark, "When it can't wait 'til morning," does not significantly change the commercial impression of the mark because the wording is in much smaller print than the mark's dominant word "Nightlight" and reinforces the connotation of nighttime pediatric care. See Azteca Restaurant, 50 USPQ2d at 1211 ("On applicant's menus, which are the specimens of record, the words appear on a line below the term AZTECA and are in smaller type than the term AZTECA. Certainly, when applicant's mark is viewed as a whole, it is the term AZTECA which is the dominating and distinguishing element thereof"). Also, while the term "pediatrics" is in larger script in opposer's mark, this generic term would not likely be considered the dominant element of opposer's mark for "pediatric medical services."

The design featured in both applicant's and opposer's marks is a crescent moon. The moon is obviously associated with the nighttime hours of the day and applicant's term "Nightlight" used in conjunction with a crescent moon design reinforces an association with nighttime. While applicant's mark includes a child perched on the moon, it is not so prominent a feature that it would obviate the likelihood of confusion between the two marks. Rather the crescent moon-dominated designs are likely to create a similar commercial impression.

In determining whether the marks are similar, we are guided by several basic principles. It is well settled that it is improper to dissect a mark. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). However, more or less weight may be given to a particular feature of a mark for rational reasons. In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Also, when we compare marks, a "[s]ide-by-side comparison is not the test. The focus must be on the 'general recollection' reasonably produced by appellant's mark and a comparison of appellee's mark therewith." Johann Maria Farina Gegenuber Dem Julichs-

Platz v. Chesebrough-Pond, Inc., 470 F.2d 1385, 176 USPQ 199, 200 (CCPA 1972) (citation omitted).

Also, while the words in opposer's mark are disclaimed, this does not mean that they are not considered in our determination whether the marks are similar. Even if a mark consists of descriptive and highly suggestive terms, this fact does not mean that the words could not be a dominant or significant part of the mark. In re National Data Corporation, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985) ("Assuming CASH MANAGEMENT is generic or at least highly descriptive in both marks, as urged by National, does not, however, lead to a reversal in this case." CASH MANAGEMENT EXCHANGE held confusingly similar to CASH MANAGEMENT ACCOUNT). In a similar case, the CCPA held that the marks PLATINUM PLUS and PLATINUM PUFF, both for hair color preparations were confusingly similar even though "platinum" is indicative of color. The Court held that even though the words "Plus" and "Puff" "may have different meanings by themselves, this difference alone does not overcome the conclusion that when the marks are viewed in their entireties a likelihood of confusion exists." Clairol Incorporated v. Roux Laboratories, 442 F.2d 980, 169 USPQ 589, 590 (CCPA 1971).

We conclude that the marks here are similar. Looking at the marks as a whole, which we must, it is apparent that they are similar in sound, appearance, meaning, and, most significantly, overall commercial impression. Particularly since they will not necessarily be viewed in a side-by-side situation, they are not so dissimilar that confusion would be unlikely.

We also note that opposer uses a design of a child and moon that it refers to in its pleading as a "secondary mark" and in its brief as "trade dress." The Federal Circuit has held that: "Ordinarily for a word mark we do not look to the trade dress, which can be changed at any time. But the trade dress may nevertheless provide evidence of whether the word mark projects a confusingly similar commercial impression." Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1284 (Fed. Cir. 1984) (citation omitted). In this case, we note that opposer uses a design of "a young child perched in a crescent shaped moon" along with its registered trademark. Brief at 3-4; Graw Ex. 9 and 14. Whether or not the child-in-moon design constitutes a protectible mark in its own right, the record reveals that opposer has frequently used the design in prominent places in its brochures and

advertising. The design is used in conjunction with opposer's registered mark and the commercial impression thereby created is remarkably similar to that of applicant's mark. The Federal Circuit has held that in a case involving the issue of likelihood of confusion between the marks PLAY-DOH and FUNDOUGH that:

> The multitude of similarities in the trade dress of PLAY-DOH and FUNDOUGH products cries out for recognition. The color (dominated by yellow), size, and shape of the packaging for both products is the same. Comparable fictitious characters in a hat adorn the packaging of both products. Both products feature promotions – discounts, rebates, and the like – in a circle with serrated edges. The marks themselves appear in coinciding locations on both products' packages. The instructions and color charts on both packages are nearly identical. Both products display a rainbow motif. These trade dress features and more – original to PLAY-DOH – have appeared on products bearing the FUNDOUGH mark. The trade dress of the marks enhances their inherently similar impression.
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> Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

Similarly here, opposer's design of a child perched in a moon enhances the similarity between opposer's registered mark and applicant's mark. The fact that applicant adds a child to its crescent moon design is unlikely to avoid a likelihood of confusion when opposer is also using a crescent moon design with a child along with its registered mark.

Next, we look at the similarities and dissimilarities between opposer's and applicant's services. Applicant's services are identified as "after-hours emergency pediatric services" and opposer's services are "pediatric medical services." We must compare the services as set out in the respective identifications in the application and registration. See In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997)(quotation marks omitted) ("Indeed, the second DuPont factor expressly mandates consideration of the similarity or dissimilarity of the services as described in an application or registration"); Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). See also Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the

particular channels of trade or the class of purchasers to which the sales of goods are directed").

Here, the services are overlapping, and therefore, they are at least in part legally identical. Opposer's services for pediatric medical services would include applicant's "after-hours emergency pediatric care" services. While in practice there may be differences in the type of care (urgent v. emergent) and the nature of the care (appointment v. walk-in), it is the services that are described in the application and registration that are at issue. Because the marks are used on overlapping pediatric services, there is a greater likelihood that when similar marks are used in this situation, confusion would be likely. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) ("When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines").

Furthermore, because there are no restrictions in the registration as to the channels of trade and applicant's services would be included within registrant's services, we must assume that the services are rendered in the same channels of trade and are

purchased by the same purchasers. Kangol Ltd. v. KangaROOS U.S.A., Inc. 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

We now address other factors that the parties have raised. We reject opposer's argument that its mark is a famous mark. The limited evidence of advertising and the very narrow geographic area in which opposer even claims it is famous (Anne Arundel and Prince George's counties, Maryland) is hardly significant evidence of fame. It is more typical of any trademark that has a modicum of success in a local market. Therefore, we decline to find that opposer's mark has achieved any significant public recognition and renown.

However, opposer has submitted evidence that there has been actual confusion between its mark and applicant's mark. Evidence of actual confusion is normally very persuasive evidence of likelihood of confusion. Exxon Corp. v. Texas Motor Exchange, Inc., 628 F.2d 500, 208 USPQ 384, 389 (5th Cir. 1980) ("The best evidence of likelihood of confusion is provided by evidence of actual confusion").

The evidence of actual confusion consists primarily of misdirected phone calls, comments at a health fair that indicate that people who were not customers thought

the same entity had two booths at the fair, and statements by a drug company representative and a local physician who thought that opposer might have opened up a new office when in fact it was applicant's office.

Courts and this Board have found vague evidence of misdirected phone calls hearsay and inadmissible. Duluth News-Tribune v. Mesabi Publishing Co., 84 F.3d 1093, 38 USPQ2d 1937, 1941 (8th Cir. 1996) ("[V]ague evidence of misdirected phone calls and mail is hearsay of a particularly unreliable nature given the lack of an opportunity for cross-examination of the caller or sender regarding the reason for the 'confusion.'"); Hi-Country Foods Corp. v. Hi Country Beef Jerky, 4 USPQ2d 1169 (TTAB 1987) ("[T]estimony from opposer's deponent, Mr. Harlan, that he received a phone call asking for beef jerky is, apart from being inadmissible hearsay, vague and unclear. The identity of the caller is unknown and the circumstances surrounding the incident are unexplained"). However, if it is otherwise reliable, employee testimony on the subject of misdirected calls can be admissible. Armco, Inc. v. Armco Burglar Alarm Co., 693 F.2d 1155, 217 USPQ 145, 149 n. 10 (5th Cir. 1982) (Testimony of plaintiff's employees about purchasers attempting to reach defendant admissible because it was either not used

"to prove the truth of the matter asserted" (Fed. R. Evid. 801(c)) or was relevant under the state of mind exception (Fed. R. Evid. 803(3))); CCBN.com Inc. v. c-call.com Inc., 53 USPQ2d 1132, 1137 (D.C. Mass. 1999) ("[S]tatements of customer confusion in the trademark context fall under the 'state of mind exception' to the hearsay rule. See Fed. R. Evid. 803(3)"). Because opposer's employees' testimony is not so vague as to be inadmissible, we overrule applicant's hearsay objection. However, the probative value of this testimony is lessened by its lack of specifics. The evidence of misdirected phone calls and the drug company representative and physician statements provide some additional support for opposer's arguments that the marks are confusingly similar. However, this evidence is counterbalanced by the fact that the parties operate in the same geographic area and yet there is, at best, only limited evidence of actual confusion by potential purchasers. Nonetheless, the absence of significant evidence of actual confusion does not mean that there is no likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983).

After we consider all the du Pont factors and the evidence of record, we conclude that there is a likelihood of confusion. Likelihood of confusion is decided upon the facts of each case. In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). The various factors may play more or less weighty roles in any particular determination of likelihood of confusion. Shell Oil, 992 F.2d at 1206, 26 USPQ2d 1688; du Pont, 476 F.2d at 1361, 177 USPQ at 567.

We have considered the limited evidence of actual confusion despite the fact that the parties operate in the same geographic area, the existence of the Utah Nightime Pediatrics clinic, and the fact that the marks are not identical, but we find these factors are outweighed by the fact that the services are overlapping, the marks present similar commercial impressions despite their specific differences, and the channels of trade and the purchasers of the services described in the registration and application are the same. Even if we assume that opposer's mark is weak, we note that "even weak marks are entitled to protection against registration of similar marks" for identical services.

In re Colonial Stores, 216 USPQ 793, 795 (TTAB 1982). See also In re The Clorox Co., 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978) (ERASE for a laundry soil and stain remover held confusingly similar to STAIN ERASER, registered on the Supplemental Register, for a stain remover). In addition, to the extent that we have any doubt, we must resolve doubts about confusion against the newcomer, which we do here. Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

As a final point, we address applicant's argument that opposer's mark "has been used in a manner inconsistent with preserving trademark rights." Brief at 23. This argument appears to allege that opposer has engaged in naked licensing of its trademark, and is an attack on the validity of an opposer's registration in an opposition proceeding. An applicant cannot collaterally attack an opposer's registration in an opposition proceeding in the absence of a counterclaim for cancellation. Contour Chair-Lounge Co. v. The Englander Co., 324 F.2d 186, 139 USPQ 285, 287 (CCPA 1963) ("[T]his is an opposition only and in an opposition, this court has always held that the validity of the opposer's registrations are not open to attack"); Cosmetically

Yours, Inc. v. Clairol, Inc., 424 F.2d 1385, 165 USPQ 515, 517 (CCPA 1970) ("As long as the registration relied upon by an opposer in an opposition proceeding remains uncanceled, it is treated as valid and entitled to the statutory presumptions"). Therefore, we will not consider applicant's argument that opposer's mark "is not properly used as a service mark associated with a single source." Applicant's Br. at 23.

Decision: The opposition is sustained and registration to applicant is refused.

Cissel, Administrative Trademark Judge, concurring:

I disagree with several of the findings of the majority, but would sustain this opposition for different reasons. Notwithstanding the fact that I do not find that applicant's mark would be likely to cause confusion with
opposer's pleaded registered mark, applicant's mark is so similar to opposer's unregistered "secondary mark" that when both are used in connection with the identical services of the parties, confusion will be likely.

The crux of my disagreement with my colleagues is that I do not find applicant's mark and opposer's pleaded and

registered mark to be so similar that confusion is likely, and I cannot characterize opposer’s "secondary" unregistered mark as "trade dress," so that mark cannot form part of the basis upon which opposer’s registered mark is compared with the mark applicant seeks to register. Nonetheless, whereas opposer's pleaded registered mark is not so similar to applicant's mark that confusion is likely, opposer's unregistered second mark, considered by itself, creates a commercial impression which is similar enough to the one engendered by the mark applicant seeks to register that confusion is likely when both are used in connection with identical services.

To begin with, I cannot agree with the conclusion of the majority that "at first glance," applicant's mark and opposer's registered mark "seem similar." It is my opinion that opposer's registered mark, when considered in its entirety, creates a different commercial impression from that which is created by the mark applicant seeks to register. This conclusion is based on the overall appearances of the marks, the different designs which appear in them and the additional wording in applicant's mark that does not appear in opposer's pleaded registered mark.

The words "Nightlight" and "Nighttime" have different connotations which play significant roles in creating the different commercial impressions these marks engender. Prospective customers for pediatric health care services are likely to know that a nightlight is a low-wattage auxiliary light frequently used in a child's bedroom to increase safety and provide a sense of security for the child. Although nightlights are used at night to illuminate the darkness, the term "nighttime" simply does not connote the same thing as "nightlight." Contrary to the majority's contention that both marks either suggest or describe pediatric care that is available when other pediatricians' offices are closed, applicant's mark, by virtue of the dominant word "nightlight" in combination with the designs of the moon and a star, suggests the security provided by a nightlight. Opposer's pleaded registered mark makes no such suggestion. When this fact is considered in conjunction with other differences between these two marks, I conclude that the marks in their entireties do not resemble each other enough to make confusion likely. While both incorporate designs of moons, the overall appearances of the marks are distinct. Applicant's mark

shows a child nestled in the curve of a crescent moon. Opposer's registered mark
shows no child, and the overall commercial impression engendered by the combination of the dominant word "nightlight" with the other wording and design elements results in a mark which is substantially different from opposer's pleaded registered mark.

When these two marks are considered in their entireties, they do not create commercial impressions which are so similar that confusion is likely. As noted above, however, while I do not find the mark applicant seeks to register to be so similar to opposer's registered mark that confusion is likely, the second mark pleaded by opposer in its Notice of Opposition, the design mark presenting a child sitting in the crescent moon, does present a bar to registration of applicant's mark under Section 2(d) of the Lanham Act. Notwithstanding what to me is a mischaracterization of this mark as "trade dress" by both applicant and the majority, the record supports my conclusion that this design, as used by applicant in its promotional materials, is a service mark in every respect. Plainly, this mark is not trade dress in the traditional sense that shapes of packages and containers and shapes of

products themselves are referred to as "trade dress." As such, it is improper to take this mark into account in determining whether confusion between opposer's pleaded registered mark and applicant's mark is likely.

When this mark is considered by itself, however, it is plainly similar to the mark applicant seeks to register. This is because both of these marks include a child nestled within a crescent moon, and star designs. Applicant's mark appropriates all the elements in opposer's unregistered mark, and the small differences in the designs and the additional wording in applicant's mark do not eliminate the likelihood of confusion.

Parents familiar with the use of opposer's unregistered mark in connection with these services, upon being presented with the mark applicant seeks to register, are likely to assume that applicant's mark identifies services provided by the same entity that renders identical services under opposer's unregistered mark.

For this reason, I concur in the result.